

view of Clancy et al. (U.S. Patent No. 5,952,998). Applicants respectfully disagree with the Examiner's contentions.

Gillespie et al. teach a touch sensor, but do not teach a transparent touch sensor. Gillespie et al. list the materials that can be used to build the sensor, however none of the listed materials are transparent or have other significant optical properties. (See Col. 9, lines 35-40).

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Establishing a *prima facie* case of obviousness requires that all elements of the invention be disclosed in the prior art. In re Wilson, 165 USPQ 494, 496 (C.C.P.A. 1970).

Even assuming that all elements of an invention are disclosed in the prior art, an Examiner cannot establish obviousness by locating references that describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would have impelled one skilled in the art to do what the patent applicant has done. Ex parte Levengood, 28 USPQ 1300 (Bd. Pat. App. Int. 1993). The references, when viewed by themselves and not in retrospect, must suggest the invention. In re Skoll, 187 USPQ 481 (C.C.P.A. 1975).

Clancey et al. does not provide a reason for one of ordinary skill in the art to modify Gillespie et al. in the manner required to meet Claims 34 or 46. In re Laskowski, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed Cir. 1989). Although the Examiner suggests that the structure in the primary art reference could readily be modified to form the claimed structure, the mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Stencel, 828 F.2d 751, 755, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987) obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion that the combination be made.

The Examiner cites that the sensor could be conductive elastomer materials. (See Paper No. 7, Page 2) In fact, conventional practice is that a transparent touchpad would not be made with conductive elastomers, but rather with a conductive film on a substrate that has optical, not electrical, properties. Therefore, there is no motivation to look to Clancy et al. for transparency. There is no teaching or suggestion to combine elements of the prior art to produce the present invention. The present invention is thus non-obvious.

Likewise, Clancy et al. do not teach grounding, nor a substantially transparent ground plane, as stated by the Examiner. Applicants were unable to find any reference to grounding in Clancy et al., let alone a transparent grounding plane. Therefore, all elements of the present invention are not disclosed in the cited art. Therefore, the Examiner has failed to make a *prima facie* case of

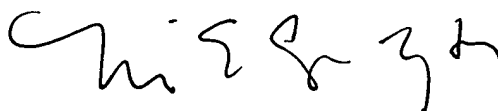
obviousness. Since Independent Claims 34 and 46 are non-obvious, all claims depending from these claims are by definition, non-obvious. In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988). Reconsideration and allowance are therefore requested.

Applicants have reviewed the prior art made of record and not relied upon by the Examiner. Applicants believe that the prior art cited comprises general information that does not render the present application anticipated or obvious.

In view of the foregoing, consideration and an early allowance of this application are earnestly solicited.

Respectfully submitted,  
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